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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/764,018 | 01/16/2001 | Rich Gioscia | PALM-3555 | 8040 |

7590 10/20/2003

WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
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| EXAMINER |
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NGUYEN, SIMON

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2685 | 2 |

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,018

Applicant(s)

GIOSCIA ET AL.

Examiner

SIMON D NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1- 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 11, 16-19, 25, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Sassi (6,487,396).

Regarding claim 1, Sassi discloses an electronic device (abstract, fig.1), comprising: a first element (#3 of figs.1, 2) comprising a first side (3b) bearing an interface (6a) operable to be used as a wireless phone (column 2 lines 41-42, column 5 line 29), a second side (3a of fig.2) comprising a first part of a display (5a) of a portable computing device (column 5 lines 28, 36); and a second element (2) comprising a third side (2a) and a fourth side (2b) wherein the third side comprising a second part of the display of the PDA; wherein the first element is movably attached with the second element (column 6 lines 40-42), and configurable in a first configuration for use as a wireless phone and configurable in a second configuration for use as the PDA (column 5 lines 24-37, column 6 lines 37-47).

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Regarding claims 16 and 30, these claim are rejected for the same reason as set forth in claim 1, wherein the electronic device further includes a processor (11 of fig.3), a memory (12 of fig.3).

Regarding claims 2-3, 17-18, Sassi further discloses the first configuration is a closed configuration (fig.1, column 5 line 29) and the second configuration is in an opened position (fig.2, column 5 line 28).

Regarding claims 4 and 19, Sassi further discloses the PDA (column 5 line 28).

Regarding claims 11 and 25, Sassi further discloses a dual-sided display (6a,5a of figs. 1, 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-10, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sassi (6,487,396) in view of in view of Cannon et al. (6,393,272).

Regarding claims 5-10 and 20-24, Sassi fails to disclose the electronic device places wireless communication on hold/ off hold and these features are displayed.

Cannon discloses a communication device including a display for displaying a call holding/off holding (column 3 lines 20-67, fig.2). It should be noted that when the user of the electronic device use a headphone or earphone, the wireless

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communications are inherently placed off hold in order the user can listen/answer the call. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Sassi, modified by Cannon in order to maintain a connection status of the incoming call as the electronic device incorporated with the PDA.

5. Claims 12, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sassi (6,487,396) in view of Katsura.

Regarding claims 12 and 26, Sassi fails to disclose the display implementing electronic ink technology.

Katsura discloses a PDA having a display implementing pen input (column 4 line 38, column 5 line 3). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Sassi, modified by Katsura to implement different techniques in use the electronic device in order to improve the system performance.

6. Claims 13-14, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sassi (6,487,396) in view of Tyneski.

Regarding claims 13-14 and 27-28, Sassi discloses at the first configuration, the display window (6a), the electronic device is used as a cellular phone (column 5 line 29), which means the electronic device inherently discloses phone-related information.

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however, Sassi fails to disclose a portion of display is visible through the display window.

Tyneski disclose an electronic device having two modes, a phone mode and a computing mode (abstract), at a phone mode a portion of display is visible through a display window (figs. 1-2, column 4 lines 28-34). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Sassi, modified by Tyneski to improve the system performance.

7. Claims 15 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sassi (6,487,396) in view of in view of Tyneski as applied to claims 14 and 28, and further in view of Imai (6,389,267).

Regarding claims 15 and 29, the modified Sassi fails to disclose a phone related information is displayed atop the surface of a second side and a third side in a flexible dual-sided display.

Imai discloses a mobile phone having a display for displaying a phone related information atop the surface of a first side and a second side in a flexible dual-sided display (fig.7A). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have the modified Sassi, modified by Imai to improve the operation of a foldedly multi-functioned communication device.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nguyen (5,797,089) discloses an electronic device operating as a mobile telephone unit when the electronic device is in a closing position and a personal digital assistant when the electronic device is in an opening position, wherein the PDA unit is a fully functional personal computer, and wherein the electronic device comprises a memory, a processor (abstract, figs. 1-3).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (703) 308-1116. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

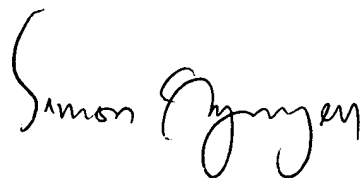
(703) 872-9314, (for formal communications intended for entry)

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Hand-delivered response should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Simon Nguyen

October 8, 2003

A handwritten signature in black ink that reads "Simon Nguyen". The signature is written in a cursive style with a large, looping "S" at the beginning and a stylized "N" at the end.